

REMARKS

1. In response to page 2 of the Office Action, Applicant acknowledges continued prosecution of pending claims 1-28, but believes no further remarks are necessary.
2. In response to the “Response to Amendment” section of the Office Action, Applicant acknowledges and appreciates the Office’s withdrawal of the § 101 rejections as to claims 1-14.
3. In response to paragraph 1 of the Office Action, Applicant acknowledges the Office rendering moot Applicant’s previous arguments of record in light of new rejections in this Office Action.
4. In response to paragraphs 2 and the Claim Rejections section of the Office Action, the Office rejects claims 1-20 under 35 U.S.C. § 103(a) as being rendered obvious by Guinta, *et al.*, U.S. Patent No. 5,737,494 (“Guinta”) in view of Prather, *et al.*, U.S. Pub. Pat. App. No. 2005/0033617 (“Prather”). Applicant objects with traverse and amendment to Guinta in view of Prather rendering obvious Applicant’s claims 1-20.

The Supreme Court recently addressed the issue of obviousness in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). “The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966) factors still control an obviousness inquiry. Those factors are: (1) ‘the scope and content of the prior art’; (2) the ‘differences between the prior art and the claims’; (3) ‘the level of ordinary skill in the pertinent art’; and (4) objective evidence of nonobviousness.”¹ “While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation test in an obviousness inquiry, the Court acknowledged the importance of identifying ‘a reason that would have prompted a person of ordinary skill in

¹ *Takeda Chemical Industries, Ltd., et al. v. Alphapharm Pty., Ltd et al.*, 2007 U.S. App. LEXIS 15349, *10 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007) (quoting the *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966))).

the relevant field to combine the elements in the way the claimed new invention does' in an obviousness determination."²

The *prima facie* case of obviousness requires: (1) some suggestion or motivation in references or in knowledge of those skilled in the art to modify a reference, (2) that the references possess a reasonable expectation of success in the modification or combination, and (3) that the references must teach or suggest all of Applicants' claim elements and limitations.³ Furthermore, the prior art "must also enable one of skill in the art to make and use the claimed invention."⁴ Below, Applicant shows that Guinta in view of Prather fails to render obvious Applicant's claims 1-20.

Amended claim 1 states: A method for improving an audit within a controlled environment, the method comprising:

determining, on an integrated, portable processing device having an interactive interface, a quality issue to address, the quality issue being associated with a product, wherein the product is the subject of the audit;

selecting, on the integrated, portable processing device, a group of questions associated with the quality issue;

posing, on the interactive interface, a question of the group of questions to gather information related to evaluation of the quality issue, wherein the integrated, portable processing device is adapted for operation within the controlled environment consisting of a clean room;

determining, on the integrated, portable processing device having the interactive interface, a sub-group of the group of questions, the sub-group being selected based upon an association with the information received in response to the question; and

storing, on ~~a database in communication with~~ memory removably integrated into the integrated, portable processing device, the information.

² *Takeda Chemical Industries, Ltd., et al. v. Alphapharm Pty., Ltd et al.*, 2007 U.S. App. LEXIS 15349, *12-13 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. at 1731 (2007)).

³ MPEP § 2142; *In re Vaec*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

⁴ *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985) (enabling disclosure required).

First, the Office cites Guinta at column 1, paragraphs 14-50 as teaching Applicant's preamble. Applicant respectfully asserts, however, that there is no mention here of anything relating to Applicant's claimed "within a controlled environment." On page 6 of the Office Action, the Office admits the same in its discussion of what Guinta does not to teach. Accordingly, Guinta does not teach Applicant's preamble.

Second, Applicant agrees with the Office that Guinta does not teach Applicant's claimed "wherein the portable processing device is adapted for operation within the controlled environment consisting of a clean room." Applicant disagrees, however, that Prather does. The Office cites Prather at FIG. 8 and FIGS 10-12. Regarding FIG. 8, for one, Prather does not textually identify any alleged "hand-held auditing computer." Instead, and for another, Prather simply and only states, "Auditing administrator's terminal 182, connected to auditing server 186 via primary network 191, may provide user interaction for administration functionality of the auditing system." Accordingly, it is clear that Prather does not teach, much less with enablement as required, Applicant's claimed "portable processing device."⁵ Additionally and alternatively, Prather says nothing about the "portable processing device" being "adapted for operation within the controlled environment consisting of a clean room."⁶

Third, Applicant has amended the claims to include "integrated" so that Applicant is claiming methods, systems and processes concerning a standalone device through use of the word "integrated". This claim amendment further highlights the claimed "portable" nature of the "processing device" and the claimed "adapted for operation within the controlled environment consisting of a clean room."

Finally, the Office previously admitted on page 14 of the last Office Action that Guinta "*does not explicitly disclose that the sub-group questions are relevant to a quality issue.*" Applicant still agrees with this admission, which means that Guinta does not teach Applicant's first or second elements' limitations of "a quality issue ... associated with a product" and "group of questions associated with the quality issue", respectively, which is

⁵ *Id.*; MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

⁶ *Id.*

necessarily tied to Applicant's fourth element's limitation regarding "sub-group of the group of questions." Prather neither cures this failed teaching nor is it alleged to have.

Based on any of the foregoing several reasons, Guinta in view of Prather fails to provide enabling teachings for all elements and limitations in contravention of the Office's allegations, and thus, the same fails to substantiate the obviousness rejections of claims 1-20.⁷ Therefore, Applicant respectfully requests withdrawal of the obviousness rejections of claims 1-20 as a matter of law.⁸

5. In response to paragraph 2 and the Claim Rejections section of the Office Action, the Office rejects claims 21-28 under 35 U.S.C. § 103(a) as being rendered obvious by Guinta in view of Prather and further in view of Danneels, *et al.*, U.S. Pat. No. 6,272,472 ("Danneels"). Applicant objects with traverse and amendment to Guinta in view of Prather and further in view of Danneels rendering obvious Applicant's claims 21-28.

As just shown, since Guinta in view of Prather does not render obvious Applicant's independent claim 1, then under the same analogy, neither is independent claim 21. Thus, any and all claims depending from independent claim 21, even in view of Danneels, are also not rendered obvious.⁹ Accordingly, and as a matter of law, Applicant respectfully requests withdrawal of the § 103(a) rejections of claims 21-28 based on Guinta in view of Prather and further in view of Danneels.¹⁰

6. In response to paragraph 3 of the Office Action, Applicant acknowledges the Office's citations to the four publications, and agrees with the Office in that the same, whether alone or in combination with any cited art, fail to anticipate or render obvious any of Applicant's claims.

⁷ *Id.*; *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then dependent claims are).

⁸ *Id.*

⁹ *Id.*

¹⁰ *Id.*

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the application is in condition for allowance. Applicant invites the Office to freely reach Applicant's attorney at the contact information found in the signature block below.

No fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

Date: June 9, 2010

/Erik J. Osterrieder/
Erik J. Osterrieder
Reg. No. 48,966
Schubert Osterrieder & Nickelson PLLC
6013 Cannon Mtn. Dr., S14
Austin, TX 78749
Tel: (713) 533-0494
Fax: (512) 301-7301
E-mail: ejo@sonlaw.com
ATTORNEY FOR APPLICANT/ASSIGNEE